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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,567	04/12/2004	Jimmie D. Burrow	125447-1005	2641

7590 04/28/2010
MICHAEL E. MARTIN
GARDERE WYNNE SEWELL LLP
1601 ELM STREET, SUITE 3000
DALLAS, TX 75201

EXAMINER

HIGGINS, GERARD T

ART UNIT	PAPER NUMBER
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1785

MAIL DATE	DELIVERY MODE
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04/28/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/822,567	Applicant(s) BURROW ET AL.	
	Examiner GERARD T. HIGGINS	Art Unit 1785	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-33,35 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-33,35 and 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/12/2010 has been entered.

Response to Amendment

2. Applicant's amendment filed on 03/12/2010 has been entered. Currently claims 29-33, 35, and 37-42 are pending and claims 1-28, 34, 36, 43, and 44 are cancelled.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

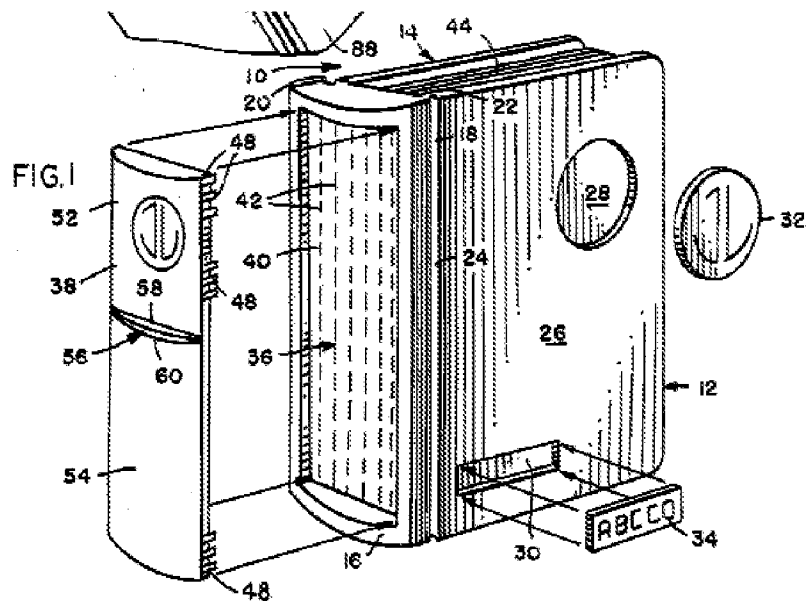
4. Claims 29-33, 37-40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) in view of Miyamoto et al. (4,460,637) and Arakaki (4,828,421).

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The Examiner notes various product-by-process limitations in applicants' claims, including that the "image sheet being bonded...to said member by pressing said member to adhere said image sheet" (claim 29), that RF energy is used to adhere/weld said image sheet to said member (claims 31 and 37), and the image sheet with transparent laminate sheet being cut according to contours of the printed image (claims 29, 37, and 38).

It has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Please see MPEP 2112 and *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Any article that has the resulting article limitations will be held to anticipate/ render obvious applicants' claimed article.

With regard to claims 29, 32, 37, 38, and 42, Errichiello disclose the article of Figure 1.



The article is a book binder **10**, which reads on applicants' article being a binder that is comprised of a front cover panel **12**, which reads on applicants' cover part or member (col. 3, lines 15-25). The front cover panel is deemed to be flexible and indentable because it is comprised of thermoplastic polymers, which will intrinsically be flexible and indentable. With regard to the term "indentable," there is no indication in applicants' claims at what temperature and pressure condition that applicants' cover part is to be "indentable," and therefore the Examiner deems the cover part indentable because as a thermoplastic polymer it is inherently indentable, e.g. above its glass transition temperature. It is also noted that there are living hinges **18** and **20** at which there is flexing, which shows the cover part or member to be flexible as claimed (col. 3, lines 26-33).

There are inserts **32** and **34**, which read on applicants' image sheet with a printed image (col. 3, line 38) of a first side thereof (col. 3, lines 34-66). These inserts are

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intrinsically flexible because they can be embossed (col. 3, lines 53-56). The inserts are bound to the front cover panel at the side opposite the indicia. The front cover panel has shallow cavities **28** and **30**, which read on applicants' indentation in a surface of said member. The inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27); however, Errichiello does not explicitly state that the indentation in the surface of the member has "a depth at least as great as the thickness of said image sheet," that the printed image is formed from ink, that there is a transparent laminate sheet overlaying the printed image and cut according to contours of the printed image, or that there is a ink receptive coating on the image sheet.

First, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the indentations in said cover part/member any depth, including at least as great as the thickness of said image sheet, in order to arrive at a book binder that had a cover panel that was smooth while still maintaining structural stability of the cover panel.

With regard to a printed image being comprised of ink, the Examiner notes again that Errichiello disclose an image sheet with a printed image (col. 3, line 38). The Examiner takes official notice that printing of inks is known in the art. Additionally, Miyamoto et al. teach that printing with ink is well-known (col. 1, lines 12-29). Miyamoto et al. also teach that it is known to place ink receptive layers on thermoplastic support materials, including polyvinyl chloride (col. 6, lines 47-63).

Since Errichiello and Arakaki are both drawn to personalized book binders; it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to have combined in the transparent covers of Arakaki over the inserts of Errichiello. The results of such a combination would have been predictable; further, each of the elements would have performed the same in combination as they had separately. The motivation to use these transparent covers is to protect the printed image on the inserts.

With specific regard to the term “cut according to the contours of the printed image,” the Examiner notes that the broadest reasonable interpretation of the word contour from Merriam-Webster Online is “**2**: the general form or structure of something.” In this way the Examiner deems that the inserts **32** and **34** of Errichiello read on the limitations “cut according to the contours of the printed image” because the inserts are cut generally to the form of the printed images thereon. Additionally, since the transparent covers of Arakaki cover a specific recessed portion, one of ordinary skill would know that the transparent covers would be the same shape as the recessed portion; hence, they would be the same size and shape as the inserts, which means that both the image sheet with the printed image and the transparent cover would have the same structure implied by the process limitations that they are “cut according to the contours of the printed image” as claimed.

With regard to claims 30, 39, and 40, Errichiello describes the inserts **32** and **34** as being molded (col. 3, line 37); furthermore, there is a spine insert **38**, which they describe as being molded from a thermoplastic polymer (col. 2, lines 10-12). It is clear to the Examiner that they front panel inserts are also molded from a thermoplastic polymer.

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Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the inserts out of the same thermoplastic polymer as the book binder. The motivation for doing so would have been to save money by using the same material to make both the customizable inserts and the book binder.

With regard to claim 31, the inserts are bound to the front cover panel by various methods, including gluing, which reads on applicants' claimed adhering, heat-sealed, which reads on applicants' claimed welding, or press-fitted (col. 2, lines 2-27). The inserts are bound to the front cover panel at the side opposite the indicia.

With regard to claim 33, any surface will intrinsically have a texture. The surface of the support material under the ink receptive coating of Errichiello in view of Miyamoto et al. and Arakaki will intrinsically possess a texture.

5. Claims 35 and 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Errichiello (4,294,469) in view of Miyamoto et al. (4,460,637) and Arakaki (4,828,421) as applied to claims 29 and 40, respectively, in view of Peterson et al. (3,190,678).

Errichiello in view of Miyamoto et al. and Arakaki render obvious all of the limitations of applicants' claims 29 and 40 in section 4 above; however they fail to disclose that the flexible plastic material of applicants' image sheet and member are formed of polyvinyl chloride.

Peterson et al. disclose book binders, including covering material comprised of thermoplastic polymers, such as polyvinyl chloride (col. 1, lines 14-16).

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Since Errichiello, Miyamoto et al., Arakaki, and Peterson et al. are both drawn to thermoplastic polymers for book binders; it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the thermoplastic polyvinyl chloride polymer of Peterson et al. for the thermoplastic polymer of Errichiello in view of Miyamoto et al. and Arakaki. The results of which would have been predictable to one having ordinary skill. The motivation to use polyvinyl chloride is that it is a ubiquitous thermoplastic that is well known for its chemical resistance.

Response to Arguments

6. Applicant's arguments, see Remarks, filed 03/12/2010, with respect to the objections to claims 29,37, and 38, the rejection of claim 37, 39-42 and 44 under 35 USC 112, first paragraph, and the rejection of claims 29-44 under 35 USC 112, second paragraph have been fully considered and are persuasive. The objections/rejections have been withdrawn.

7. Applicant's arguments filed 03/12/2010 have been fully considered but they are not persuasive.

Applicants argue that the references do not disclose that the inserts are shaped to the contours of the printed image as claimed.

The Examiner respectfully disagrees and notes the broadest reasonable interpretation of the word contour from Merriam-Webster Online is “**2**: the general form or structure of something.” In this way the Examiner deems that the inserts **32** and **34**

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of Errichiello read on the limitations “cut according to the contours of the printed image” because the inserts are cut generally to the form of the printed images thereon.

Additionally, since the transparent covers of Arakaki cover a specific recessed portion, one of ordinary skill would know that the transparent covers would be the same shape as the recessed portion; hence, they would be the same size and shape as the inserts, which means that both the image sheet with the printed image and the transparent cover would have the same structure implied by the process limitations that they are “cut according to the contours of the printed image” as claimed.

Applicants argue that the molded inserts would have a different structure than an insert cut from a sheet.

The Examiner respectfully disagrees and notes that the Examiner has made a *prima facie* case above that the inserts of Errichiello in view of Miyamoto et al. and Arakaki would have the same structure despite being made by a different process. Applicants have not explained how the structure of inserts cut from a sheet would differ from the prior art; further, applicants have not provided any evidence to show how the prior art insert would differ from the currently claimed image sheet.

Applicants argue that the fact that the transparent laminate sheet is also cut according to the contours of the printed image defines the present invention over the prior art.

The Examiner respectfully disagrees and notes the new reference Arakaki (4,828,421), which teaches that a recessed portion **48** that may contain personal indicia, which may then be covered with a transparent cover (col. 3, lines 23-28). This reads on

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the transparent laminate sheet cut according to the contours of the printed image of applicants' claims.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 10am-8pm est. (Variable one work-at-home day).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Ruthkosky can be reached on 571-272-1291. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Ruthkosky/
Supervisory Patent Examiner, Art Unit 1785

GERARD T. HIGGINS
Examiner
Art Unit 1785

/G. T. H./
Examiner, Art Unit 1785